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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/326,691	06/07/1999	KENJI MATSUO	Q54675	4511

7590 03/13/2002

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EXAMINER
MULCAHY, PETER D

ART UNIT	PAPER NUMBER
1713	14

DATE MAILED: 03/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/326,691	Applicant(s) MATSUO ET AL.	
	Examiner Peter D. Mulcahy	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 February 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-8 and 10-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-8 and 10-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *13* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

The Information Disclosure Statement provided by applicants has been initialed, signed and a photocopy is enclosed for applicants' record.

At this time the Examiner finds the limitations of claims 1, 2, 3 and 8 when taken in combination to be allowable. The art currently of record does not anticipate or render obvious the subject matter of these claims when taken in combination.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negatived by the manner in which the invention was made.

Claim 20 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Blok et al.

The Blok patent shows compounds which anticipate applicants' instantly claimed compound A. This patent further teaches to incorporate these compounds into rubber compositions. The Examiner maintains that the utilization of this rubber composition as a tire and more specifically the reinforcing layer of a tire is anticipated and/or rendered obvious by this disclosure. The manufacture of tires is clearly shown throughout the disclosure of this patent. It would be reasonable to presume that any portion of the tire formulated by this composition could be considered to be a reinforcing layer. This is because the reinforcing nature of the composition is seen to be a property limitation which is inherently possessed by any compositions which incorporate component A in combination with the rubber composition. This patent shows the utilization of component A in combination with the rubber and as such,the claim limitations are seen to be anticipated.

Claims 16-19 and 21 are rejected under 35 U.S.C. 102(b) or (e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 070143 or J09151279.

The rejection as set forth under 35 U.S.C. § 102/103 i n Paper No. 5 is deemed proper and is herein repeated.

These claims are anticipated and/or rendered obvious from this art given that the two component composition is shown and it is suggested to use the rubber compositions in tire manufacture. Based on the rationale as set forth supra, it is reasonable to presume that a tire which incorporates the two component rubber composition would inherently possess the reinforcing properties as instantly claimed. As such, these claims are seen to be anticipated by the prior art.

Claims 1-3, 5-8 and 10-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 070143 or J09151279 taken in view of Blok.

The rejection as set forth under 35 U.S.C. § 103 in Paper No. 5 is deemed proper and is herein repeated. The Examiner maintains that each of these compounds is known and is clearly shown to be utilized in rubber compositions for the manufacture of tires. One of ordinary skill in the art would find it prima facie obvious to combine these ingredients given that they are known ingredients and have been utilized in rubber compositions in the past. It is noted that obviousness does not require absolute predictability, but rather a reasonable expectation of success. The Examiner maintains that one of ordinary skill in the art would have a reasonable expectation of success when

combining these ingredients in rubber compositions given that they are known ingredients and have been utilized in tire applications as shown in the prior art.

Applicants' arguments relative to the unexpected results have been fully considered but have been deemed to be not persuasive. Applicants' claims are not commensurate in scope with any unexpected results in that there are no percent limitations or property limitations possessed by many of the claims and as such the claims read on compositions which incorporate mere trace amounts of the ingredients and the unexpected results would not be expected for compositions which incorporate disproportionate amounts of the components or mere trace amounts of these ingredients. As such, the claims remain unpatentable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy, whose telephone number is (703) 308-2449. The examiner can normally be reached on Tuesday through Friday from 7:30 A.M. to 6:00 P.M.

The fax telephone number for this group is (703) 305-3599.

Any inquiry of general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2351.

P. Mulcahy:cdc
March 11, 2002

PETER D. MULCAHY
PRIMARY EXAMINER
GROUP 1500